

REMARKS

Claims 11-16 and 19-30 are pending in the application. Claims 20, 23-25, and 28 are withdrawn as being directed to nonelected species. In the Office Action mailed April 7, 2008, claims 11-16, 19, 21, 22, 26, 27, 29, and 30 are rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The action further notes that EP 1314783-A1 in the Information Disclosure Statement filed December 1, 2006 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance of each patent listed that is not in the English language.

I. Information Disclosure Statement

The action notes that EP 1314783-A1 in the Information Disclosure Statement filed December 1, 2006 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance of each patent listed that is not in the English language.

Upon investigation, the Applicants have determined that EP 1314783-A1 was erroneously included in the Information Disclosure Statement filed December 1, 2006 due to a “cut and paste”-type typographical error made in the office of the Applicants’ attorney. The Applicants note that the publication date of EP 1314783-A1 is May 28, 2003, not November 22, 2001, as erroneously listed on the Information Disclosure Statement, and further note that the true publication date of EP 1314783-A1 is thus after the priority date of the present application (December 10, 2002). EP 1314783-A1 is therefore not citable as prior art against the present application and thus EP 1314783-A1 has no relevance to the present application. Furthermore, the Applicants have confirmed that none of the members of the “patent family” of EP 1314783-A1 has an effective prior art date before the priority date of the present application, so no counterpart applications to EP 1314783-A1 have relevance to the present application. A list of the family members of EP 1314783-A1 is reproduced on the next page for the Examiner’s convenience. The Applicants specifically note that the PCT application from which the counterpart U.S. national stage application (U.S. Pat. App. Ser. No. 10/496,263) derives its filing date was not published in English, so the U.S. national stage application is not available as prior art against the present application under 35 U.S.C. 102(e) [see also MPEP 706.02(f)(1): Example 5; MPEP 901.03].

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Family list

7 family members for: EP1314783
Derived from 5 applications

Back to EP1314783

- 1 NUCLEIC ACID LINKERS AND USE THEREOF IN GENE SYNTHESIS
Inventor: SCHATZ OCTAVIAN; O'CONNELL TIMOTHY Applicant: SLONING BIO TECHNOLOGY GMBH
EC: C12N15/10C100; C12N15/10; (+2) IPC: C12N15/10; C12N15/66; C12P19/34 (+4)
Publication info: AU2002352108 A1 - 2003-06-10
AU2002352108 A8 - 2003-06-10
- 2 NUCLEIC ACID LINKERS AND THEIR USE IN GENE SYNTHESIS
Inventor: O'CONNELL TIMOTHY (DE); SCHATZ OCTAVIAN (DE) Applicant: SLONING BIO TECHNOLOGY GMBH (DE)
EC: C12N15/10C100; C12N15/10; (+2) IPC: C12N15/10; C12N15/66; C12P19/34 (+7)
Publication info: CA2468235 A1 - 2003-05-30
- 3 Nucleic acid linkers and their use in gene synthesis
Inventor: SCHATZ OCTAVIAN DR (DE); O'CONNELL TIMOTHY DR (DE) Applicant: SLONING BIOTECHNOLOGY GMBH (DE)
EC: C12N15/10C100; C12N15/10; (+2) IPC: C12N15/10; C12N15/66; C12P19/34 (+6)
Publication info: EP1314783 A1 - 2003-05-28
- 4 Nucleic Acid Linkers and Use Thereof in Gene Synthesis
Inventor: SCHATZ OCTAVIAN (DE); O'CONNELL TIMOTHY (DE) Applicant:
EC: C12N15/10C100; C12N15/10; (+2) IPC: C12P19/28; C12N15/10; C12N15/66 (+4)
Publication info: US2008044862 A1 - 2008-02-21
- 5 NUCLEIC ACID LINKERS AND USE THEREOF IN GENE SYNTHESIS
Inventor: SCHATZ OCTAVIAN (DE); O'CONNELL TIMOTHY (DE) Applicant: SLONING BIO TECHNOLOGY GMBH (DE); SCHATZ OCTAVIAN (DE); (+1)
EC: C12N15/10C100; C12N15/10; (+2) IPC: C12N15/10; C12N15/66; C12P19/34 (+4)
Publication info: WO03044193 A2 - 2003-05-30
WO03044193 A3 - 2004-04-08

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The Applicants apologize for this error, and respectfully request that the Applicants' erroneous citation of EP 1314783-A1 in the Information Disclosure Statement filed December 1, 2006 be considered withdrawn.

II. Rejections under 35 U.S.C. 112, second paragraph

Claims 11-16, 19, 21, 22, 26, 27, 29, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite. In particular, independent claims 11, 12, and 13 are rejected as being indefinite because, "in view of step a), it is unclear that a plurality or pool of nucleic acid molecules in step a) are second extension products or not. Furthermore, since step a) does not require that said second extension product is a double stranded nucleic acid, if said second extension product is a single stranded, said second extension product must comprise complementary strand of said first and second 3' and 5' region but not comprise said first and

second 3' and 5' region as recited in step c)". Although not stated, the Applicants have presumed in this response that claims 14-16, 19, 21, 22, 26, 27, 29, and 30 are rejected solely for being dependent upon a rejected base claim. The Applicants respectfully traverse the rejections. Claims 11-13 have herein been amended in order to more distinctly claim and point out the Applicants' invention. In particular, the Applicants have herein amended independent claims 11-13 in order to recite that the second extension product comprises complementary first and second 3' and 5' regions and that the nucleic acid molecule comprises the second extension product. Support for this amendment is found at least at paragraphs [0064] -[0070] and in Figs. 1A-F. No new matter is added by these amendments, entry of which is therefore respectfully requested.

The amendments made to independent claims 11-13 clarify that the nucleic acid molecules in step a) are second extension products and that the second extension product comprises complementary strands to the first and second 3' and 5' regions. The Applicants believe that these amendments resolve the indefiniteness issues raised by the rejections. Reconsideration and withdrawal of the rejections of independent claims 11-13, as amended, under 35 U.S.C. 112, second paragraph, is therefore respectfully requested.

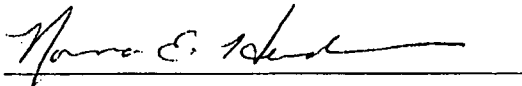
Because claims 14-16 and 19 depend from currently amended independent claim 11, which is now in condition for allowance, claims 14-16 and 19 are also in condition for allowance. Reconsideration and withdrawal of the rejection of claims 14-16 and 19 is therefore respectfully requested. Because claims 20 and 21 depend from currently amended independent claim 12, which is now in condition for allowance, claims 20 and 21 are also in condition for allowance. Reconsideration and withdrawal of the rejection of claims 20 and 21 is therefore also respectfully requested. Because claims 26, 27, 29, and 30 depend from currently amended independent claim 13, which is in condition for allowance, claims 26, 27, 29, and 30 are also in condition for allowance. Reconsideration and withdrawal of the rejection of claims 26, 27, 29, and 30 is therefore also respectfully requested.

The indefiniteness issues being resolved, the Applicants respectfully submit that claims 11-16, 19, 21, 22, 26, 27, 29, and 30 are neither anticipated nor rendered obvious by any art of record, none of which teaches removal and control of errors in nucleic acid molecules having a user-specified sequence and length and synthesized by the specific process of the Applicants, in combination with the other claimed elements of the Applicants invention, as recited in currently amended independent claims 11-13. Allowance of claims 11-16, 19, 21, 22, 26, 27, 29, and 30 is therefore respectfully requested.

III. Conclusion

A Request for Continued Examination (RCE) is being submitted with this response. Claims 11-13 have been amended. No new matter is presented by these amendments. The Applicants respectfully submit that claims 11-16, 19, 21, 22, 26, 27, 29, and 30 are now in condition for allowance, which action is now requested. For this reason, and in view of the foregoing arguments, the Applicants believe that this application is now in condition for allowance, which action is respectfully solicited. Should there remain any unresolved issues, it is respectfully requested that the Examiner telephone Norma E. Henderson, Applicants' Attorney, at 603-437-4400, so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,



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Date

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